

REMARKS

A. General.

Claims 1-4 and 6-20 are pending in this application after entry of this amendment. Independent claims 1 and 4 are amended. New independent claim 17 and new dependent claims 18-20 are added.

B. Rejections under 35 U.S.C. § 103.

The Examiner rejected claims 1-4 and 6-16 under 35 U.S.C. § 103(a) as being “unpatentable over Marnell II ... [U.S. Patent No. 5,393,057; ‘Marnell II’] in view of Manship ... [U.S. Patent No. 5,393,061; ‘Manship et al.’].” See Office Action, ¶ 3. The Examiner further rejected claims 7-16 as being unpatentable over Manship et al. in view of Marnell II. See id., ¶ 5.

Marnell II discloses the combination of “an electronic primary gaming device ... such as a poker game; and [an] electronic secondary gaming device, such as a bingo-type gaming device” See col. 2, lines 36-41. Marnell II further discloses that “When predetermined results occur in the primary game, such as a poker hand ... these results are automatically entered in the secondary game.” See id., col. 2, lines 47-51. Thus the “secondary game” is a random game (e.g., bingo).

Manship et al. disclose a video gaming machine on which the wheels of a slot machine are simulated. See Abstract. During primary play, display elements are randomly selected from a look-up table. See col. 4, line 60 - col. 5, line 12. Manship et al. then disclose two additional payout modes. There is a bonus in which bonus credits are accumulated based on one payout table (e.g., table 66 as shown in Fig. 4E) and paid out based on a second payout table (e.g., the “all fruit” combination in table 64, as shown in Fig. 4D). See col. 6, line 32 - col. 7, line 9. There is also a “fever mode” which the machine enters when it randomly

generates a particular pattern of symbols, and which also pays out based on payout tables.

See col. 7, lines 10-63. Thus Manship et al. disclose both a bonus and “fever mode” aspect of a game that are subject to random payout.

Applicants’ independent claim 1 is patentable over Marnell II and Manship et al. because the combination of these two references does not disclose or suggest all claimed elements. Applicants’ claim 1, as amended, recites, for example, “generating a first game result pursuant to a first game, by displaying a combination of symbols randomly selected from a first set of symbols” and “initiating a bonus game, said bonus game being other than a random game.” (emphasis added) Applicants’ independent claim 4, as amended, recites similar language and therefore is likewise patentable over the combination of Marnell II and Manship et al. Since independent claims 1 and 4 are patentable, claims depending thereon are patentable for at least the same reasons.

C. Rejections under 35 U.S.C. § 102.

The Examiner rejected claims 1-4 and 6 as being “anticipated” by Manship et al. See Office Action, ¶ 4. For at least the reasons discussed above, Applicants believe that independent claims 1 and 4, and claims depending therefrom, are patentable because Manship et al. does not disclose or suggest each and every element of Applicants’ claims.

D. Patentability of new claims.

Support for Applicants’ new claims is found, for example, in Figs. 2-5 and associated text. Applicants’ new independent claim 17 recites, for example, “randomly generating a first game result” and “generating a bonus game, wherein the bonus game comprises non-randomly generating a bonus game result, and wherein non-randomly generating the bonus game result comprises associating a second particular first game result with generating a

count value.” Therefore, new claim 17 and claims depending therefrom are patentable over the combination of Marnell II and Manship et al.

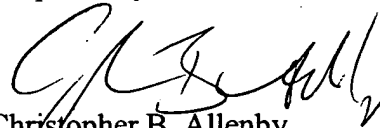
E. Request.

Applicants request the Examiner reconsider, allow all pending claims, and pass this application to issue. If the Examiner’s next action is other than to allow all claims, Applicants invite the Examiner to telephone the undersigned attorney at 408-453-9200 ext. 1253 so as to expedite prosecution of this application.

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Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

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I. IN THE CLAIMS

1. (Three times amended) A method of operating a slot machine, said method comprising:

generating a first game result pursuant to a first game, by displaying a combination of symbols randomly selected from a first set of symbols, using circuitry within said slot machine;

displaying said first game result on a video screen of said slot machine;

if said first game result meets certain criteria, initiating a bonus game, said bonus game being other than a random [selection of symbols by said circuitry so as not to be a version of said first] game, said bonus game generating and displaying a bonus game result using said circuitry and displaying said bonus game result on said video screen,

said generating and displaying said first game result and said bonus game result being performed by the same hardware in said slot machine so as to require no additional hardware to generate and display said bonus game result; and
granting an award to a player based on said first game result and said bonus game result.

4. (Three times amended) A slot machine comprising:

circuitry within said slot machine for generating a first game result pursuant to a first game, by displaying a combination of symbols randomly selected from a first set of symbols;

a video display screen on said slot machine for displaying said first game result; and

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circuitry within said slot machine for initiating a bonus game, said bonus game being other than a random [selection of symbols by said circuitry so as not to be a version of said first] game, said bonus game generating and displaying a bonus game result, if said first game result meets certain criteria, and displaying said bonus game result on said video screen;

wherein generating and displaying said first game result and said bonus game result is performed by the same hardware in said slot machine so as to require no additional hardware to generate and display said bonus game result.

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